

### **REMARKS/ARGUMENTS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1-3, 5-9, and 11-16 are now pending.

Original claims 1-3, 5, 6 and 8-14 were rejected under 35 U.S.C. 102(b) as being anticipated by Shouji et al.

The Examiner's indication that claims 4 and 7 contain allowable subject matter is noted with appreciation. The allowable limitations of claim 4 have been incorporated into an amended claim 1 so that claims 1-3, 5-6, and 8-9 should now be allowed. Further, allowable claim 7 has been re-presented in independent form so that claim 7 should now be allowable.

Claims 11, 12 and 14 have been revised above so as to be presented in independent form, incorporating the limitations of claim 10 therein. The Examiner's rejection is respectfully traversed with respect to claims 11, 12 and 14 and the claims dependent therefrom.

Anticipation under Section 102 of the Patent Act requires that a prior art reference disclose every claim element of the claimed invention. See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1574 (Fed. Cir. 1986). While other references may be used to interpret an allegedly anticipating reference, anticipation must be found in a single reference. See, e.g., Studiengesellschaft Kohle, G.m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-27 (Fed. Cir. 1984). The absence of any element of the claim from the cited reference negates anticipation. See, e.g., Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715 (Fed. Cir. 1984). Anticipation is not shown even if the differences between the claims and the prior art reference are insubstantial and the missing elements could be supplied by the

knowledge of one skilled in the art. See, e.g., Structural Rubber Prods., 749 F.2d at 716-17.

Claim 11 provides that the nozzle needle is rotated about an axis of the nozzle needle in a circumferential direction when the material applied to the distal end of the nozzle needle has liquidity. Contrary to the Examiner's characterization of Shouji, there is no disclosure of rotating a nozzle needle to which a lipophobic material is applied. In fact, from a review of the Shouji patent, the terms "turn", "rotate", "rotating" and/or "axis" cannot even be found. It is therefore respectfully submitted that claim 11, and claim 13 dependent therefrom, are not anticipated by Shouji. It is further respectfully submitted that the invention claimed is not obvious from Shouji either.

It is clear that the initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. In re Piasecki, 745 F. 2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to arrive at the claimed invention from the prior art. Ex parte Clapp, 227 USPQ 972 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp. 837 F.2d 1044, 7 USPQ 2d 1434 (Fed. Cir. 1988).

Because none of the references of record discloses the details of the claimed invention lacking in Shouji, nor the unique advantages thereof, there can be no suggestion to modify Shouji in this respect. See In re Civitello, 339 F.2d 243, 144 USPQ 10, (CCPA 1964).

In view of the foregoing, it is respectfully submitted that claim 11 is not anticipated by nor obvious from the applied art.

Claim 12 recites that the nozzle needle is rotated about a perpendicular axis, which is perpendicular to the axis of the nozzle needle, when the lipophobic material applied to the distal end of the nozzle needle has liquidity. The cited reference Shouji does not disclose rotating the nozzle needle to which the lipophobic material is applied. In fact, the terms "perpendicular", "axis" and "rotate" can not even be found in the Shouji patent. Thus, there is no teaching of the rotation recited in independent claim 12. Consequently, claim 12 is not anticipated by nor obvious from Shouji.

Claim 15 should be allowable by virtue of its dependence on claim 12.

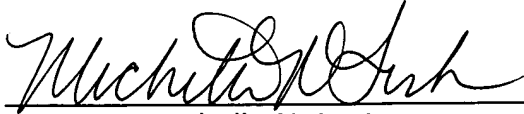
Claim 14 includes the step of cutting at least the portion of the lipophobic material applied to the distal end of the nozzle needle to adjust at least one of the area of the lipophobic material and the thickness of the lipophobic material. Shouji does not teach or suggest cutting the lipophobic material applied to the nozzle needle. In fact, the term "cut" is not present in the Shouji disclosure. As such, claim 14 is not anticipated by Shouji. Because neither Shouji nor the remaining art of record teach or suggest the addition of this step to the Shouji process, it is respectfully submitted that the invention is not obvious from Shouji either. It is therefore respectfully submitted that claim 14, and claim 16 dependent thereon are not anticipated by nor obvious from the applied art.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

NIWA  
Appl. No. 10/600,372  
October 19, 2004

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:   
Michelle N. Lester  
Reg. No. 32,331

MNL:slj  
1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100

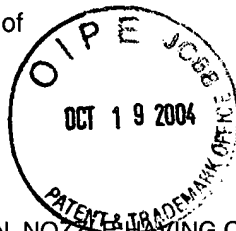
## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 2018-736

C# M#

NIWA



TC/A.U.

3747

Serial No. 10/600,372

Examiner: Gimie

Filed: June 19, 2003

Date: October 19, 2004

Title: FUEL INJECTION NOZZLE HAVING COATING LAYER AND MANUFACTURING METHOD THEREOF

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE/AMENDMENT/LETTER**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☐ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

Total effective claims after amendment **14** minus highest number  
previously paid for **20** (at least 20) = **0** x \$ **18.00** \$ **0.00**

Independent claims after amendment **5** minus highest number  
previously paid for **3** (at least 3) = **2** x \$ **88.00** \$ **176.00**

If proper multiple dependent claims now added for first time, add \$300.00 (ignore improper) \$ **0.00**

Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$430.00/2 months; \$980.00/3 months) \$ **0.00**

Terminal disclaimer enclosed, add \$ 110.00 \$ **0.00**

☐ First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$790.00) \$ **0.00**

☐ Please enter the previously unentered, filed

☐ Submission attached

**Subtotal** \$ **176.00**

If "small entity," then enter half (1/2) of subtotal and subtract -\$ **0.00**

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00) \$ **0.00**

Assignment Recording Fee (\$40.00) \$ **0.00**

Other: **0.00**

**TOTAL FEE ENCLOSED** \$ **176.00**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

1100 North Glebe Road, 8<sup>th</sup> Floor  
Arlington, Virginia 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100  
MNL:slj

NIXON &amp; VANDERHYE P.C.

By Atty: Michelle N. Lester, Reg. No. 32,331

Signature: 